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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 37

Application Number: 08/932,784  
Filing Date: September 18, 1997  
Appellant(s): MCKAIN ET AL.

PETER J. GORDON  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 December 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

Claims on Appeal : 1, 9 and 23.

Claims canceled : 2-8, 10-22 and 24-44.

Claim amended : 23.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 23 December 2002 has been entered.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 1, 9 and 23 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,946,445	PETERS et al	8-1999
5,109,482	BOHRMAN	4-1992
5,488,433	WASHINO et al	1-1996
5,579,239	FREEMAN et al	11-1996
JP405153448A	OSAMU	6-1993

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al (5,488,433) in view of Freeman et al (5,579,239) and Osamu (J P405153448).

Regarding claims 1, 9 and 23, Washino et al. discloses a digital motion picture recorder (Figs 1 and 2) comprising a motion picture camera (video camera) for providing a motion video signal; means for converting the motion video signal into a sequence of digital still images and compressing the sequence of digital still image (column 4, lines 57-68); and means for storing the sequence of digital still images on a rewritable random-access medium (70) in a computer readable file form (column 10, lines 9-25).

Washino further teaches that the digital storage medium is employed in the housing of the camera and the stored digital still picture can be implemented for editing (column 4, lines 13-32) but fails to specifically teach an editing means in the housing of the camera for specifying a sequence of the stored digital still picture. However, it is noted that using an editing means for specifying a sequence of stored digital video signal is well known in the art as taught by Freeman. Freeman teaches an editing means used with (2) within a computer for editing a video signal captured from a video camera and recorded on a random access memory (column 2, line 59 to column 3, line 7, column 6, lines 8-20, Fig. 2) for defining a sequence of the still picture of the motion

picture . Therefore, it would have been obvious to one of ordinary skill in the art to modify Washino with Freeman by installing the editing means as taught by Freeman in the recorder of Washino to enable edit the stored digital still pictures by specify a sequence of the still digital still pictures, thereby providing more convenience to the user in editing the stored digital sill picture captured by the camera .

Washino as modified with Freeman fails to teach that the editing means mounted in the housing of the recorder. However, it is noted that installing an editing means within a housing of a recorder and camera is well known in the art as taught by Osamu.

It would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman with Osamu by using the teaching as suggested by Osamu to install the editing means as taught by Freeman within the recorder of Washino thereby provide more convenience to the user in handling the editing the captured digital motion data.

3. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al (5,946,445) in view of Bohrman and Osamu (JP405153448).

Regarding claims 1, 9 and 23, Peters discloses a digital motion picture recorder comprising:

- a housing sized to bye portable for use by an individual (Fig. 1);
- processing means ( Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal;

a converting means for converting the motion video signal into a sequence of the still image (column 2);

storage means (5) for storing the sequence of still images on a computer readable and writable random access medium mounted in the housing (column 3).

Peters at figure 1 fails to specifically teach that the motion camera mounted in the housing having the recorder. However, it is noted that combining a camera with recorder for making a portable apparatus is well known in the art as taught by Osamu . Therefore, it would have been obvious to one of ordinary skill in the art to modify the digital recorder of Peters by providing a motion camera in the same housing of the digital recorder for portability's purpose therefore providing more advantages to the user in handling the apparatus for capturing the desired the motion signal . Furthermore, Peter at column 3, lines 44-54 teaches the computer and video system can be designated for portability to use on-site or live recording and in the specification of the instant application ( page 4) teaches that a camera which integral with a digital recorder to make portable is well recognized in the art.

Peters as modified with Osamu further teaches the use of means for reading out and playing back the selected stored sequences of digital still pictures ( files or clips) from the medium (See Peters, column 3, lines 1-42) but fails to specifically teaches an editing means used for specifying a sequence of the stored digital picture to be played back.

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Bohrman teaches an editing unit which is used with a computer for editing the pre-stored video information, defining a sequence of the digital still pictures to be read out from the computer medium to play back the digital still pictures (column 3).

It would have been obvious to one of ordinary skill in the art to modify Peters with Bohrman by using an editing device as taught by Bohrman in the apparatus of Peters for editing the digital still pictures by defining sequences of the digital still picture to be read out and play back the sequences of the digital still pictures.

**(11) Response to Argument**

1. The combination of Washino, Freeman and Osamu.

Applicants agree that :

“ None of the cited references alone teaches or suggests a housing sized to be portable for use by an individual, a motion picture camera mounted in the housing, a digital, computer-readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file format, and a system within the housing for specifying a sequence of segments of the sequence of digital still images.”

In response, the examiner disagrees. It is submitted that the combination of the cited references will teach or suggest “a housing sized to be portable for use by an individual, a motion picture camera mounted in the housing, a digital, computer-readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file

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format, and a system within the housing for specifying a sequence of segments of the sequence of digital still images.” since the Washino reference teaches a housing sized to be portable mounted with a camera and a recorder and a control system (computer) (Figs.1 and 2 column 4, lines 14-32) for processing the digital motion picture from a camera , implementing editing of the digital motion picture and recording the digital motion picture on a random access readable and writable computer medium , Freeman teaches a portable computer having means for storing the digital motion pictures and an editing means for defining sequences of the digital still pictures to be played back (column 2, line 45 to column 3 line 21) and Osamu teaches a camera having a housing mounted with a recorder and a system for performing editing function on the video signal.

## 2. The combination of Peters, Osamu and Bohrman

Applicants agree that :

“ None of the cited references alone teaches or suggests a housing sized to be portable for use by an individual, a motion picture camera mounted in the housing, a digital, computer-readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file format, and a system within the housing for specifying a sequence of segments of the sequence of digital still images.”

In response, the examiner disagrees. It is submitted that the combination of the cited references will teaches or suggest “a housing sized to be portable for use by an individual, a motion picture camera mounted in the housing, a digital, computer-

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readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file format, and a system within the housing for specifying a sequence of segments of the sequence of digital still images.” since Peters reference teaches a housing sized to be portable mounted with a camera and a recorder and a control system (computer) (Figs.1 , column 1 lines 58-68 , column 3 ) for processing the digital motion picture from video signal of a camera, recording the digital motion picture on a random access readable and writable computer medium , defining sequences of the still pictures of the digital motion pictures (digital motion picture data is a combination of the digital still pictures) , Bohrman teaches a computer having means for storing the digital motion pictures that is a portable apparatus , defining sequences of the digital still pictures to be played back (column 3) and Osamu teaches that a camera, a recorder and an editing means can be incorporated in the same housing sized to be portable to a user. Further , it is noted that Peters , at column 3 lines 43-53, teaches that the computer and video system can be adapted for portability .

Applicants further argue that “ Any proposed combination or modification of prior art references must be explained by a reason from the prior art that is supported by substantial evidence.” In response it is noted that the combination of Washino and Freeman and Peters and Bohrman are supported by evidence being taught and suggested by Osamu . The combination of a camera, recorder or computer and an editing means in the same housing would provide advantages to the user in handling capturing desired motion pictures and convenience to the user in selecting the

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sequences of the stored digital still images to be played back for viewing or editing .

Providing the advantages and conveniences to the user is the reasons to motivate one of ordinary skill in the art to combine Washino with Freeman and Peters with Bohrman and also being suggested and taught by Osamu .

Applicants further argue that Osamu does not teach an editing means for defining sequences of stored digital still picture to be read out and play back. In response, it is noted that the examiner relies on Osamu as the reference teaches the camera, recorder and editing means are mounted within the same housing to provide more advantage and convenience to the user in capturing desired picture signals and editing the picture signals. The processing digital still picture data , storing the digital still picture data and defining sequences of stored the digital still pictures are disclosed by Washino, Freeman, Peters and Bohrman.

Applicants argue that "Because the references would not have suggested a means for defining a sequence of segments of the sequence of digital still images stored on the digital, computer-readable and writable random-access medium, they also would not have suggested any means for reading and outputting at least a portion of the sequence of digital still images from the digital computer readable and writable random-access medium according to the defined sequence of segments," as recited in claims 9 and 23." In response, the examiner disagrees . It is noted that Freeman , Peters and Bohrman teach editing means for defining a sequence of segments of the digital still pictures and reading the sequence of the segment of the still pictures . Freeman at column 3 teaches that the video signal from a camera is processed into digital motion

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picture data comprising still pictures ( a digital motion picture data is a combination of plurality of digital still pictures) stored on a digital computer readable and writable medium . The stored still pictures are selected and readout from the medium in response to an editing function (column 2, line 59 to column 3 line 23). Peters at column 3 teaches the sequences of the stored digital still pictures are defined to play in sequences (clips). Bohrman at columns 3 and 4 teaches the stored digital still pictures are to be read out in sequences of segments by using in- points and out-points to determine the start and end of a sequence . Further, it is noted that Freeman , Peters and Bohrman teach the use of computers to execute instruction in response to the user to define the selected sequences of the digital still pictures to be read out from the medium.

For the above reasons, it is believed that the rejections should be sustained.

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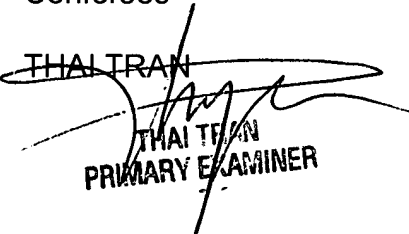
Respectfully submitted,

  
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March 10, 2003

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